

REMARKS

Claim Rejections Under Section 103(a)

Claims 1 to 4 and 26 to 28 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent number 6,641,663 to Kemmochi et al. (hereinafter "Kemmochi") in argued combination with Sato (U.S. patent 6,136,092), Ohama (U.S. patent pub. 2002/0192409) and Nakajima et al. (U.S. patent 5,306,473).

The Kemmochi patent issued on November 4, 2003 from a U.S. application that was published on June 12, 2003.

The present application is the U.S. national stage of an international application filed on May 21, 2004, which is the effective U.S. filing date for this application.

The Kemmochi application was published eleven months and nine days prior to the effective U.S. filing date, and therefore it is not available as a publication reference.

Kemmochi is potential prior art only under 35 U.S.C. § 102(e).

35 U.S.C. § 103(c)(1) states that:

subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102... shall not preclude patentability where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Section 103(c)(2) further states that:

subject matter developed by another person and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person if:

- (a) the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made;
- (b) the claimed invention was made as a result of the activities undertaken within the scope of the joint research agreement; and
- (c) the application for patent for the claimed invention discloses or is intended to disclose the names of the parties to the joint research agreement.

The invention of the present application was made under a joint research agreement between Heraeus Quarzglas GmbH (now Heraeus Quarzglas GmbH & Co. KG) and Shin-Etsu Quartz Products, Ltd. The invention of the Kemmochi patent was developed under a linked subsequent agreement between Heraeus Quarzglas GmbH, Shin-Etsu Quartz Products, Ltd., and Shin-Etsu America. Heraeus Shin-Etsu America, the holder of the Kemmochi patent, is owned by Heraeus Quarzglas GmbH & Co. KG (25%) and Shin-Etsu Quartz Products (75%). Shin-Etsu Quartz Products is 50% owned by Heraeus Quarzglas GmbH & Co. KG.

A statement as required by 35 U.S.C. § 103(c)(2) is attached, and a paragraph identifying the parties to the joint research agreement has here been inserted in the specification, as required by 35 U.S.C. § 103(c)(2)(c).

A check, including the amount of \$130.00, is enclosed to meet the fee for assertion of this joint research agreement at this stage of the prosecution. Should the check be insufficient or not found, please deduct any necessary fee from deposit account 501659.

Accordingly, under 35 U.S.C. sec. 103(c), the obviousness rejection in the present application should be withdrawn because the main reference of the rejection, the Kemmochi patent, is excluded from use in an obviousness rejection.

DOUBLE-PATENTING REJECTION

The Examiner has also rejected claims 1 to 14 and 16-28 for double patenting over U.S. patent 7,299,658 in view of Kemmochi.

Without regard to any substantive issues of the rejection or the reliance on the excluded Kemmochi reference, to advance the application to allowance, applicant submits herewith for each of the owners of the present application a terminal disclaimer of this patent application over U.S. patent 7,299,658. A check including the requisite fees of \$260.00 is also enclosed for submitting the disclaimer.

Based on submission of this disclaimer, it is believed that the double patenting rejection should be withdrawn.

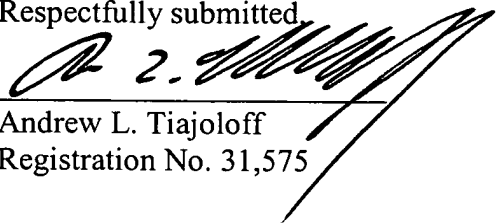
All objections of the Examiner having been addressed, and the prior art of the obviousness rejection having been excluded under 35 U.S.C. § 103(c), formal allowance is respectfully requested.

Should any questions arise, the Patent Office is invited to telephone attorney for applicants at 212-490-3285.

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Respectfully submitted


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